

The opinion in support of the decision being entered
today was not written for publication and is not
binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

AUG 30 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR R. SANCHEZ, ALBERTO CEJA
and RIGOBERTO ANGUIANO

Appeal No. 2004-1849
Application No. 09/753,171¹

ON BRIEF

Before KIMLIN, OWENS and DELMENDO, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 38-57.

Appellants seek reissue of U.S. Patent No. 5,635,235, which
issued on June 3, 1997. Appellants filed an original reissue
application on June 3, 1999, which matured into Reissue Patent

¹ Application filed December 29, 2000, for reissue of U.S. Patent No. 5,635,235, issued June 3, 1997.

Appeal No. 2004-1849
Application No. 09/753,171

No. RE 37,008 on January 2, 2001. The present, second reissue application was filed on December 29, 2000, before the issue date of RE 37,008. The instant reissue application contains claims that are broader in several respects than the claims in U.S. Patent No. 5,635,235 and the original reissue application. Appellants have not filed a supplemental oath or declaration in support of the broadened claims of the present application but, instead, rely upon the reissue oath in the first reissue application.

Appealed claims 38-57 stand rejected under 35 U.S.C. § 251 for three separate reasons, namely, (1) the claims are based upon a defective reissue declaration, (2) original Patent No. 5,635,235 has expired due to non-payment of maintenance fees, and (3) the broadened claims were filed outside the two-year statutory period.

We consider first the second reason advanced by the examiner in support of the rejection of the appealed claims under § 251. U.S. Patent No. 5,635,235 issued on June 3, 1997, and, therefore, the first maintenance fee was not due until June 3, 2001. However, on June 3, 1999, appellants filed the first reissue application, and on March 9, 2001, appellants paid the appropriate maintenance fee. Accordingly, the maintenance fee on

Appeal No. 2004-1849
Application No. 09/753,171

RE 37,008 is not due until June 5, 2005. Consequently, we cannot sustain this basis for the examiner's rejection under 35 U.S.C. § 251.

We also do not agree with the examiner's third reason for rejecting the appealed claims under § 251, i.e., that the present reissue application containing broadened claims was filed more than two years after the issue date of U.S. Patent No. 5,635,235. As appellants contend, it is proper for an applicant to file broadened claims in a reissue application more than two years after the patent date as long as a broadened reissue application containing the additional broadened claims was filed within the two-year statutory period. In re Doll, 419 F.2d 925, 926, 164 USPQ 218, 219 (CCPA 1970). It has also been held that plural reissue patents can be granted from the same original patent and that § 251 does not bar divisional or continuation reissue applications, as long as the continuing reissue application does not introduce broadened claims for the first time after the two-year statutory period. In re Graff, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997). As a result, since an applicant is authorized to file a continuation reissue application and may file broadened claims in a reissue application after the two-year period if the public was on notice

within the two-year period of an original broadened reissue claim, it logically follows that, as here, an applicant may file a continuation reissue application which contains claims broader than the original patent in respects that are different than the broader claims in the parent reissue application that were filed within the two-year period.

We will sustain the examiner's rejection to the extent that the appealed claims are based upon a defective reissue declaration which fails to provide adequate support for the newly broadened claims in this continuation reissue application. The declaration in the parent reissue application, upon which appellants rely, specified one error in the original patent, namely, "[t]he claims directed to a Divertor Gate are too narrow." Appellants do not dispute the examiner's identification of a plurality of additional errors associated with the broadened claims of the present application which are not specified in the declaration of the parent application (see paragraph bridging pages 3-4 of Answer). 37 CFR § 1.175(b)(1) states the following:

For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance . . .

Appeal No. 2004-1849
Application No. 09/753,171

In our view, the declaration in the parent reissue application does not cover the errors sought to be corrected in the present reissue application. While Doll, supra, found that the broadened claims submitted after the two-year period were adequately supported by the reissue oath, Doll does not stand for the proposition that any original reissue oath is necessarily adequate for all ensuing broadening amendments that are totally unrelated to the errors specified in the original reissue oath or declaration. When a continuation reissue application is filed based upon a different set of facts than those relied on in the parent reissue application, it is not seen how a copy of the oath or declaration filed in the parent reissue application can be in compliance with the requirements outlined in 37 CFR § 1.175 outlined above. We note that appellants submit that "if the Board determines that new reissue declarations are required, the Patentee requests that it be given sufficient time to obtain such declarations from the non-cooperative inventors" (page 9 of Brief, last sentence).

In conclusion, based on the foregoing, the examiner's rejection under 35 U.S.C. § 251 is sustained to the extent that the appealed claims are based upon a defective reissue

Appeal No. 2004-1849
Application No. 09/753,171

declaration. Accordingly, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Edward C. Kimlin
EDWARD C. KIMLIN)
Administrative Patent Judge)
)
)
)
)
Terry J. Owens)
TERRY J. OWENS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
Romulo H. Delmendo)
ROMULO H. DELMENDO)
Administrative Patent Judge)

ECK:clm

Appeal No. 2004-1849
Application No. 09/753,171

Myers, Dawes & Andras
19900 MacArthur Boulevard
Suite 1150
Irvine, CA 92612